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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/159,833	09/24/1998	KENICHI UTSUMI	1990.62597	5612

24978 7590 05/21/2003

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EXAMINER

JACKSON, JENISE E

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 05/21/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/159,833

Applicant(s)

UTSUMI ET AL.

Examiner

Jenise E Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☐ Other: \_\_\_\_\_.

***Detailed Office Action***

***Claim Rejections - 35 USC § 112-New Matter***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-21 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The applicant's original specification on page 4, states that the password preserving unit preserves a default input password and a password for access protection. Furthermore, it states that when there is no password input from the user, the password verifying unit substitutes the default input password for the user input password with the password for access protection. *There is no mention of a general access password.* The Examiner asserts what is a general access password? Is the general access password different from the default password? The Examiner is unclear as to what the difference is between both passwords.

3. Claims 1-2, 5, and 18 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Hideo.

4. As per claims 1 and 18, Hideo discloses a storing apparatus that is an IC card(8) for protecting access to information on the card by a password, and a password preserving unit that stores a default password(password information previously stored) and a password for access protection(password stored on the card). Also, Hideo discloses a password verifying that is a

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comparing part(31), because the comparing part verifies the default password and the access protected password by comparing the two passwords for access to the information stored on the card. If a user forgets his/her password, as a result, the user cannot input his/her password for access, thus the password information that was previously stored is substituted for a user input password and compared to the password that is stored on the IC card. Furthermore, Hideo discloses in the detailed description, that if a user inputs his/her password a comparison is made between the inputted password and the password for access protection.

5. As per claim 2, according to Merriam-Webster's Collegiate Dictionary, the definition of comparing is to be equal or a like(see pg. 234). Hideo discloses that the default password and the password for access protection are compared(same value) to allow access to the information stored on the card. Therefore, it is obvious that both passwords have the same value, because comparing passwords that have the same value, is an efficient method that insures that only authorized users are granted access.

6. As per claim 5, the Examiner takes Official Notice that the step of storing passwords on a non-volatile memory is well-known. The motivation to store data(i.e. passwords) on a non-volatile memory is that the passwords that are stored, are not lost when there is a power failure or when power is shut down. Therefore, it is obvious to have non-volatile storage, because non-volatile storage is a more secure method of storing passwords, than volatile memory.

#### ***Response To Amendment***

7. The applicant states that Hideo does not disclose a storage apparatus in which a general

access password can be used to allow essentially free access to the storage apparatus by a first or second user. The Examiner disagrees, Hideo discloses RAM(30)(storage apparatus) that holds the password number that is compared with the IC card that contains a password, to allow the user free access. The Examiner asserts that this free access is that the user does not have to type in his/her password, because the IC card contains a password and is compared to the password in RAM(30).

8. On page 4, of Applicant's response to Amendment paper number 13, the Applicant states that the 112 is traversed because the term general access password represents the multiple passwords that are stored in the preserving unit. The Applicant cites the specification on page 16, lines 8-11. The portion that was cited by the Applicant does not disclose a general access password that has multiple passwords stored in the preserving unit. The cited portion of the Applicant discloses a default password, a write/read password, and a read only password. There is no mention of a general access password. The 112 rejection remains.

9. The Applicant states there are two separate passwords needed to control access to the medium. The Examiner agrees that there are two passwords a general access password and a password. However, the Applicant again cited the specification on page, 16, lines 8-27, Applicant states that the access password is divided into a write/read password, and read password. However, there is no mention of a access password.

10. The Applicant states that the present invention is an authorized usage is initiated by the default password or a user input password matching the access password, a second user can then access medium continuously. The Applicant then further states the present invention on page 6. However, this is not reflected in the claims. The Examiner is to broadly interpret the claims with

respect to the specification. The Examiner is not suppose to read the specification into the claims. Thus, Hideo remains rejected by the claims.

11. The Applicant states that the Hideo reference is the same password that is stored on the card. Further, the Applicant states that the same exact password is stored on the device and the IC card. The Examiner asserts that the claimed invention, does not state that the two passwords are different. The Applicant is urged to look at claim 1, which states "a password preserving unit for preserving a general access password and the password". The Applicant has claimed two passwords. However, it does not state that there are two separate passwords or two different, or independent passwords. Therefore, the Applicant's remarks in regards to the two passwords of Hideo are the same is a moot point.

12. Also, on page 8, of paper 13, the Applicant states that Hideo has different benefits and purposes from the present invention. The Examiner asserts that if the Applicant wants to claim benefits and purposes of the present invention, than it needs to be claimed.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jenise E Jackson whose telephone number is (703) 306-0426. The examiner can normally be reached on M-Th (6:00 a.m. - 3:30 p.m.) alternate Friday's.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes can be reached on (703) 305-9711. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-0040 for regular communications and (703) 308-6306 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.



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May 16, 2003



GAIL HAYES  
SUPERVISORY PATENT EXAMINER  
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